

PATENTS

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Docket No.: STAT1010

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:)	Group Art Unit: 2877
)	
PETITE, Thomas D.)	Examiner: Evans, Fannie L.
)	
Serial No.: 08/825,576)	Confirmation No: 1135
)	
Filed: March 31, 1997)	Docket No.: STAT1010
)	
Title: TRANSMITTER FOR ACCESSING AUTOMATED FINANCIAL TRANSACTION MACHINES		

I certify that this correspondence is being transmitted to:
Commissioner for Patents, P.O. Box 1450, Alexandria,
Virginia 22313-1450 via the USPTO's EFS-Web
electronic filing systems on **20 JUNE 2006**.

/jameshuntvanceyjr53809/
James Hunt Yancey, Jr., USPTO Reg. 53,809

RESPONSE TO NOTICE OF ALLOWANCE

**Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450**

Dear Honorable Sir:

The *Notice of Allowance*, from Examiner Fannie L. Evans of Art Unit 2877, dated 5 April 2006, has been received and carefully reviewed. In response thereto, Applicant respectfully submits this *Response To Notice of Allowance* to address references previously submitted with an *Information Disclosure Statement* submitted on 7 December 2005. As discussed below in more detail, Applicant respectfully requests the Examiner to review the enclosed references because Applicant's postcard shows that the USPTO received the previously submitted references.

I. Prosecution History of The Present Application

Applicant filed the Present Application on 31 March 1997. After an appeal to the Board of Patent Appeals and Interferences (“BPAI”), the Examiner initially allowed Claims 26-28 in a 20 December 2005 *Notice of Allowance*. Rather than submit the appropriate issue fees in response to the *Notice of Allowance*, Applicant submitted a *Request for Continued Examination* (“RCE”) on 13 January 2006 so that the Examiner would consider certain references Applicant submitted in several Information Disclosure Statements (“IDS”). Applicant submitted the RCE/IDS submission to comply with 37 C.F.R. § 1.56 to submit references that came to light during pendency of appeal before the BPAI.

Prior to the 20 December 2005 *Notice of Allowance* Applicant submitted one such IDS on 7 December 2005¹ in accordance with 37 C.F.R. § 1.97(c).² This IDS submission contained numerous references, both patent literature and non-patent literature references. In addition to submitting these references in the Present Application, Applicant also submitted these same references in other co-pending applications in full compliance with the provisions of 37 C.F.R. § 1.56. Some of the non-patent literature documents submitted in the 7 December 2005 IDS submission were labeled as citation numbers 47-54. In accordance with current IDS submission rules, Applicant submitted copies of citation numbers 47-54.

After submitting the 7 December 2005 IDS submission, Applicant believed that the USPTO had received citation numbers 47-54. Applicant believed this because USPTO officials provided Applicant the enclosed return postcard (See Exhibit A). As shown, the return postcard bears an official USPTO stamp dated 15 December 2005. Because USPTO officials did not mark-up or otherwise alter the information on Applicant’s return postcard, Applicant respectfully asserts that the USPTO received all references submitted in Applicant’s 7 December 2005 IDS submission, including citation numbers 47-54. *See* MPEP § 503, “Return Postcard” Section.

¹ Applicant submitted multiple IDS submission during prosecution of this Application. Applicant refers to the date of mailing rather than the date of receipt at the USPTO to distinguish between the multiple IDS submissions because each mailed submission included a certificate of mailing. *See* 37 C.F.R. § 1.8.

² Applicant submitted additional IDS submissions on 5 December 2005 and 16 December 2005, which were submitted prior to 20 December 2005. In accordance with 37 C.F.R. 1.97(c), Applicant believes that all of these IDS submissions should have been reviewed since they were submitted prior to the mailing date of a notice of allowance. *See* 37 C.F.R. 1.97(c).

Applicant believes that the Examiner should have reviewed the 7 December 2005 IDS submission in accordance with 37 C.F.R. § 1.97(c). Because the Examiner did not comply with 37 C.F.R. § 1.97(c), Applicant filed the 13 January 2006 RCE to ensure that the Examiner would consider Applicant's December 2005 IDS submissions even though Applicant filed the IDS submissions prior to the mailing date of the 20 December 2005 IDS.

II. The 4 April 2006 Notice of Allowance

In response to the 13 January 2006 RCE, the Examiner issued a second *Notice of Allowance* dated 5 April 2006. The second *Notice of Allowance* again allowed Claims 26-28 in light of Applicant's IDS submissions. In reviewing the second *Notice of Allowance*, Applicant discovered that the Examiner did not review citation number 47-54 submitted in the 7 December 2005 IDS submission. Indeed, the Examiner asserts that copies of citation numbers 47-54 were not submitted by Applicant. As evidenced by the enclosed USPTO stamped return receipt postcard, Applicant respectfully disagrees with the Examiner.

The MPEP expressly provides that a postcard not altered by USPTO personnel upon receipt serves as a *prima facie* evidence that the USPTO received all correspondence identified on the return postcard. See MPEP § 503, "Return Postcard" Section Heading. Because Applicant's return postcard submitted with the 7 December 2005 IDS submission was not altered by USPTO personnel, Applicant respectfully asserts that citation number 47-54 in the 7 December 2005 IDS submission were provided to the USPTO.

In light of the enclosed return postcard, Applicant respectfully requests the Examiner to consider citation numbers 47-54. As explained above, Applicant respectfully asserts that the USPTO received copies of citation numbers 47-54 since USPTO personnel did not mark up or otherwise alter Applicant's return postcard. In addition, Applicant also notes that the exact same IDS submission was submitted in several other co-pending applications and that no other Examiner asserted citation numbers 47-54 as missing. Upon receiving the 5 April 2006 *Notice of Allowance* the undersigned reviewed the private PAIR file for the Present Application. It appears that USPTO personnel inadvertently failed to scan in citation numbers 47-54 into the USPTO Image File Wrapper system. In light of what has transpired, Applicant resubmits citation numbers 47-54 simultaneously with this submission via EFS-Web and respectfully requests the Examiner to review these references.

Applicant notes that the prosecution of the Present Application has been unduly extended. The review of Applicant's IDS submissions should have occurred prior to the 20 December 2005 *Notice of Allowance* in accordance with 37 C.F.R. § 1.97(c). In any event, Applicant filed an RCE to have Applicant's IDS submissions reviewed by the Examiner rather than obtain a patent. Given Applicant's return receipt postcard, Applicant respectfully requests the Examiner to review the unreviewed references or at the very minimum issue a *Supplemental Notice of Allowance*. In short, Applicant believes that it should not be forced to submit a second RCE given that USPTO processing errors led to the Examiner's decision to not review citation numbers 47-54 in the 5 April 2005 *Notice of Allowance*.

III. Citation Numbers 47-54 from the 7 December 2005 IDS Submission

In the two *Notice of Allowances* issued during the Present Application, the Examiner cited the BPAI's decision regarding the reasons for allowance of Claims 26-28 of the Present Application. While not required to do so, the undersigned compared the BPAI's decision with citation numbers 47-54. In light of the BPAI's decision for allowing Claims 26-28, it appears that citation numbers 47-54 do not disturb or affect the BPAI's decision and that Claims 26-28 are allowable over citation numbers 47-54. It also appears that citation numbers 47-54 are cumulative of references already reviewed by the Examiner. The undersigned, however, respectfully requests that the Examiner conduct a separate review of the resubmitted references and acknowledge such review by initialing the enclosed IDS form.

IV. Fees & Conclusion

No fees are believed due with this submission, but the Commissioner is hereby authorized to charge any fees deemed due to Deposit Account No. 20-1507. Applicant respectfully requests the Examiner to review the resubmitted references and acknowledge that the references do not affect the allowability of Claims 26-28. The Examiner is respectfully solicited to telephone the undersigned regarding this submission with any questions or concerns.

Respectfully submitted,

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DATE: 20 JUNE 2006

EXHIBIT A

IN THE U.S. PATENT AND TRADEMARK OFFICE

TS Mail Room: Return to Docket Clerk 49
Date: December 1, 2005

Pat./Ser. No.: 08/825,576

Inventor: Thomas Petite

Client: StatSignal IPC, LLC

Title: TRANSMITTER FOR ACCESSING AUTOMATED FINANCIAL TRANSACTION MACHINES

The following has been received in the U.S. Patent and Trademark Office on the date stamped hereon:

1. Transmittal Form
 2. Fee Transmittal
 3. Transmittal of Information Disclosure Statement (2 pgs.)
 4. Information Disclosure Statement (Form PTO/SB/08B) (~~6 pgs~~) *9 pages*
 5. Cited references (*59 refs.*)
 6. Power of Attorney
 7. Statement Under 37 CFR 3.73(b)
 8. Assignment (*4 PAGES*)
 5. Return Receipt Postcard
-

Attorney Docket No.: STAT1010
Attorney/Paralegal: Yancey/Dysart

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